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In re Application of : DECISION ON  
MILSTEIN, Cesar et al. :  
Application No.: 10/506,906 :  
PCT No.: PCT/GB03/00974 : REQUEST  
Int. Filing Date: 07 March 2003 :  
Priority Date: 07 March 2002 : UNDER 37 CFR 1.42 AND  
Attorney's Docket No.: DYC0101PUSA :  
For: SCD FINGERPRINTS : PETITION UNDER 37 CFR 1.182

This is a decision on applicants' "Renewed Petition Under 37 C.F.R. §1.42," and "Petition Under 37 C.F.R. §1.182," filed in the United States Patent and Trademark Office on 07 November 2005.

**BACKGROUND**

On 07 March 2003, applicants filed international application PCT/GB03/00974, which claimed a priority date of 07 March 2002. A copy of the international application was transmitted to the Office by the International Bureau on 12 September 2003. The deadline for entry into the national stage in the United States was 07 September 2004.

On 07 September 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 30 March 2005, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

On 23 May 2005, applicants submitted a declaration of the inventors, indicating that inventor Milstein was deceased. It was treated as a request for status under 37 CFR 1.42.

On 04 August 2005, the Office mailed Decision on Request Under 37 CFR 1.42, refusing applicants' request.

On 07 November 2005, applicants submitted a petition under 37 CFR 1.182 and a second declaration of the inventors.

**DISCUSSION**

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The "legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 CFR 1.42.

On 23 May 2005, applicants submitted a declaration of the inventors, executed by the inventors and the legal representative of Mr. Milstein. The declaration appeared to list the information for the inventors, including the Cesar Milstein, but did not list the required information for the legal representative, Ms. Celia Prilleltensky Milstein. As indicated, the declaration must list the inventors and their citizenships and the legal representative and the legal representative's citizenship, residence and postal address. See 37 CFR 1.497.

On 07 November 2005, applicants submitted two copies of a second declaration of the inventors. The first copy lists inventors Cesar Milstein, Adrian Woolfson and Charles Nicholas Hales and the citizenship for inventor Woolfson and lists legal representatives Celia Prilleltensky Milstein and Margaret Hales and their citizenships. It is unclear to whom the mailing addresses belong. This copy is executed by Margaret Hales. The second copy of the declaration lists the inventors and legal representative Celia Prilleltensky Milstein and the citizenships of inventor Woolfson, inventor Hales and of legal representative Milstein. It does not list the citizenship for Cesar Milstein and it is not clear that it lists a mailing address for the legal representative. This second copy is executed by Milstein's legal representative, inventor Woolfson and Margaret Hales. The entry for inventor Hales is crossed out. The alteration is neither dated nor initialed.

This second declaration is defective because (1) it does not list all of the inventors and their citizenships and the legal representatives and their citizenships, residences and postal addresses and (2) it contains non-dated, non-initialed alterations, striking inventor Hales. The 23 May 2005 declaration was defective only as to legal representative Milstein. Applicants must supply an oath or declaration listing all of the inventors and their citizenships and legal representative Milstein and her citizenship, residence and postal address. The supplemental declaration need only be executed by Celia Prilleltensky Milstein. The indication that the misspelling of her name on the international application was the result of a typographical error is sufficient to correct her name.

#### Petition Under 37 CFR 1.182

In the international application, the third joint inventor was listed as C. N. Hales. An inventor is required to be listed by at least one given name. Applicants have supplied a petition under 37 CFR 1.182 to correct inventor Hales' name. The explanation supplied by inventor Hales' legal representative is sufficient. The fee for a petition under 37 CFR 1.182 is \$400. The balance of the petition fee will be charged to deposit account no. 02-3978, as authorized.

#### CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

The petition under 37 CFR 1.182 is **GRANTED**.

Applicant is required to submit a declaration in compliance with 37 CFR 1.497 and 1.42 within a time period of **TWO (2) MONTHS** from the mail date of this Decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT. Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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